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Paper No.

SEP 02 2009

OFFICE OF PETITIONS

In re Application of :
Dowling et al. :
Application No. 09/739,587 : LETTER REGARDING
Filed: December 15, 2000 : PATENT TERM ADJUSTMENT
Attorney Docket No. 07844-476001 :
/ P440 :
Title: HINTED STEM PLACEMENT ON :
HIGH-RESOLUTION PIXEL GRID :

This is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed February 5, 2009. Pursuant to their duty of good faith and candor to the Office, applicants disclose that the initial determination of patent term adjustment of three hundred and ninety-two (392) days may be longer than appropriate.

The request for review of the patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is ONE HUNDRED SIXTEEN (116) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 5, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 392 days. Applicants give no basis for their request.

Nonetheless, a review of the application history supports a conclusion that Applicants are correct.

37 CFR 1.704(c)(10) states that circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

- Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
 - (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
 - (ii) Four months; and

On several occasions, applicants failed to engage in reasonable efforts to conclude examination by filing an amendment or paper after the mailing of a notice of allowance.

After a Request for Continued Examination timely filed December 22, 2003, a second notice of allowance was mailed on May 17, 2004. A Rule 312 amendment was subsequently received on August 16, 2004, and a response to the Rule 312 amendment was mailed on September 22, 2004. The patent term adjustment will be reduced by an additional 38 days for this failure to engage.

Similarly, after this second notice of allowance, a petition to withdraw from issue, a Request for Continued Examination (RCE) and an Information Disclosure Statement (IDS) were filed on October 29, 2004. A decision which granted the petition to withdraw from issue was mailed on November 2, 2004 (a 5-day reduction). The IDS did not include a §1.704(d) statement. A notice of allowance was mailed in reply to the RCE and IDS on March 8, 2005 (a 131 day period). Since the 5-day reduction for the petition to withdraw from issue overlaps with the 131-day reduction period for the RCE and IDS submitted on October 29, 2004, a total period of 131 days for applicant delay is being entered for this failure to engage.

Moreover, after the third notice of allowance was mailed on March 8, 2005, an RCE, another IDS and another Petition to Withdraw from Issue were filed on November 22, 2006. A plurality of additional IDS submissions were subsequently filed on March 14, 2007, May 7, 2007 and October 4, 2007. None of the IDSs included a 1.704(d) statement. It appears that the RCE and IDS filed November 22, 2006 and subsequently-filed IDSs were responded to via the mailing of a non-final Office action on January 22, 2008 (a 427-day reduction), and the Petition to Withdraw from Issue was granted via the mailing of a decision on December 21, 2006 (a 30-day reduction). Since the 30-day reduction for the petition to withdraw from issue and the 427-day reduction for the RCE and IDSs overlap, a total period of 427 days for applicant delay is being entered. The currently-assigned period of 318 days associated with the IDS filed October 4, 2007 is being removed as this period is included in the 427-day reduction.

Finally, the 37 CFR 1.702(a)(2) states that the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed. With respect to the above-mentioned RCE filed on November 22, 2006, a non-final Office action was mailed four months and 306 days later on January 22, 2008. The Office currently has this period of adjustment entered as 308 days. The period of 308 days of examination delay is being removed and a period of 306 days of examination delay is being entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 116 days.

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the \$200.00 fee under 37 C.F.R. § 1.18(e). The Office thanks Applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in

the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanowski at (571) 272-3225.

A handwritten signature in black ink, appearing to read "Nancy Johnson", written over the typed name.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

Day : Saturday
Date: 8/29/2009

PALM INTRANET

Time: 17:28:05

PTA Calculations for Application: 09/739587			
Application Filing Date:	12/15/2000	PTO Delay (PTO):	729
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	337
Post-Issue Petitions:	0	Total PTA (days):	116
PTO Delay Adjustment:	-276		

File Contents History					
Number	Date	Contents Description	PTO	APPL	START
173	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		306	
172	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	308		
171	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	308		
170	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		306	
169	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	318		
168	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	306		
167	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		308	
166	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		427	
165	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		131	
164	08/29/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		38	
145	11/05/2008	MAIL NOTICE OF ALLOWANCE			
142	10/17/2008	ISSUE REVISION COMPLETED			
141	10/17/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
140	10/17/2008	DOCUMENT VERIFICATION			
139	10/17/2008	NOTICE OF ALLOWABILITY			
138	12/03/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
137	09/20/2008	DATE FORWARDED TO EXAMINER			
136	09/16/2008	AMENDMENT AFTER FINAL REJECTION			
135	05/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		16	128
134	05/08/2008	REFERENCE CAPTURE ON IDS			
133	12/03/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
132	07/30/2008	MAIL FINAL REJECTION (PTOL - 326)			
131	07/30/2008	FINAL REJECTION			

130	05/08/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
129	05/21/2008	DATE FORWARDED TO EXAMINER			
128	04/22/2008	RESPONSE AFTER NON-FINAL ACTION			
126	05/08/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
125	10/04/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
124	01/22/2008	MAIL NON-FINAL REJECTION	308		92
123	12/03/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
122	12/03/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
120	10/04/2007	REFERENCE CAPTURE ON IDS			
119	10/04/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		318	92
118	10/04/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
117	10/01/2007	NON-FINAL REJECTION			
116	07/22/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
115	06/06/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
114	06/06/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
113	03/14/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
112	03/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
111	11/22/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
110	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
109	10/29/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
108	10/29/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
107	05/07/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
106	05/07/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
105	05/07/2007	REFERENCE CAPTURE ON IDS			

104	05/07/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
103	03/14/2007	REFERENCE CAPTURE ON IDS			
102	03/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
101	11/22/2006	REFERENCE CAPTURE ON IDS			
100	11/22/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
99	06/12/2007	DATE FORWARDED TO EXAMINER			
98	11/22/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
97	06/12/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
96	12/21/2006	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
95	11/22/2006	PETITION ENTERED			
94	12/01/2006	TC RETURN TO PUBS			
93	11/27/2006	RECONSTRUCTION COMPLETED			
92	11/20/2006	RESPONSE TO 37 CFR 1.251 NOTICE - PAPERS PROVIDED FOR FILE RECONSTRUCTION		2	89
91	11/22/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
90	08/14/2006	PUBS CASE REMAND TO TC			
89	08/18/2006	MAIL RECONSTRUCTION NOTICE - PENDING APPLICATION			
88	08/18/2006	RECONSTRUCTION NOTICE UNDER 37 CFR 1.251 - PENDING APPLICATION			
87	08/18/2006	RECONSTRUCTION OF FILE - BEGIN			
86	08/12/2006	WORKFLOW - QUERY REQUEST - BEGIN			
85	06/07/2005	WORKFLOW - DRAWINGS FINISHED			
84	06/07/2005	ISSUE FEE PAYMENT VERIFIED			
83	07/05/2006	FILE MARKED LOST			
82	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
81	11/01/2004	WORKFLOW - REQUEST FOR RCE - FINISH			
80	12/12/2005	RECEIPT INTO PUBS			
79	06/07/2005	ISSUE FEE PAYMENT RECEIVED			
78	08/16/2004	REVERSE ISSUE FEE			
77	03/08/2005	MAIL NOTICE OF ALLOWANCE			
76	03/08/2005	MAIL FORMAL DRAWINGS REQUIRED			
75	03/07/2005	FORMAL DRAWINGS REQUIRED			
		NOTICE OF ALLOWANCE DATA VERIFICATION			

74	03/07/2005	COMPLETED			
73	03/07/2005	NOTICE OF ALLOWABILITY			
72	03/04/2005	CASE DOCKETED TO EXAMINER IN GAU			
71	11/30/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - FINISH			
70	11/30/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - BEGIN			
69	11/23/2004	PATENT ISSUE DATE USED IN PTA CALCULATION			
68	11/01/2004	WORKFLOW - REQUEST FOR RCE - BEGIN			
67	11/02/2004	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
66	11/01/2004	PETITION ENTERED			
65	10/25/2004	RECEIPT INTO PUBS			
64	10/22/2004	DISPATCH TO FDC			
63	10/22/2004	APPLICATION IS CONSIDERED READY FOR ISSUE			
62	05/17/2004	CORRECTION - DRAWING NOT REQUIRED			
61	08/16/2004	ISSUE FEE PAYMENT VERIFIED			
60	10/18/2004	RECEIPT INTO PUBS			
58	09/22/2004	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			
57	09/21/2004	RESPONSE TO AMENDMENT UNDER RULE 312			
56	09/21/2004	CASE DOCKETED TO EXAMINER IN GAU			
55	08/16/2004	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
54	12/23/2003	NEW OR ADDITIONAL DRAWING FILED			
53	08/27/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - FINISH			
52	08/27/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - BEGIN			
51	08/27/2004	RECEIPT INTO PUBS			
50	08/20/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - FINISH			
49	08/20/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - BEGIN			
48	08/16/2004	WORKFLOW INCOMING AMENDMENT IFW			
47	08/16/2004	ISSUE FEE PAYMENT RECEIVED			
46	08/18/2004	RECEIPT INTO PUBS			
45	06/03/2004	WORKFLOW - CUSTOMER SERVICE REQUEST -			

		FINISH			
44	06/03/2004	WORKFLOW - CUSTOMER SERVICE REQUEST - BEGIN			
43	05/25/2004	RECEIPT INTO PUBS			
42	05/17/2004	MAIL NOTICE OF ALLOWANCE			
41	05/17/2004	MAIL FORMAL DRAWINGS REQUIRED	25		33
40	05/14/2004	FORMAL DRAWINGS REQUIRED			
39	05/14/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
38	05/14/2004	NOTICE OF ALLOWABILITY			
37.7	12/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	12/22/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	03/22/2004	DATE FORWARDED TO EXAMINER			
35	12/22/2003	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
34	03/22/2004	DATE FORWARDED TO EXAMINER			
33	12/22/2003	REQUEST FOR CONTINUED EXAMINATION (RCE)			
32	03/22/2004	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
31	12/22/2003	WORKFLOW - REQUEST FOR RCE - FINISH			
30	12/22/2003	WORKFLOW - REQUEST FOR RCE - BEGIN			
29	11/12/2003	RECEIPT INTO PUBS			
28	10/01/2003	WORKFLOW - FILE SENT TO CONTRACTOR			
27	09/29/2003	RECEIPT INTO PUBS			
26	09/26/2003	DISPATCH TO PUBLICATIONS			
25	09/25/2003	MAIL NOTICE OF ALLOWANCE			
24	09/25/2003	MAIL FORMAL DRAWINGS REQUIRED			
23	09/24/2003	FORMAL DRAWINGS REQUIRED			
22	09/24/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
21	09/24/2003	NOTICE OF ALLOWABILITY			
20	09/23/2003	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
19	09/10/2003	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
18	09/18/2003	MISCELLANEOUS INCOMING LETTER			
17	07/12/2003	DATE FORWARDED TO EXAMINER			

16	06/19/2003	RESPONSE AFTER NON-FINAL ACTION		1	15
15	03/18/2003	MAIL NON-FINAL REJECTION	396		-1
14	03/10/2003	NON-FINAL REJECTION			
13	12/06/2002	CASE DOCKETED TO EXAMINER IN GAU			
12	12/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	12/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
10	05/21/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	09/14/2001	CASE DOCKETED TO EXAMINER IN GAU			
8.7	06/04/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	06/04/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	06/21/2001	APPLICATION DISPATCHED FROM OIPE			
6	03/05/2001	APPLICATION IS NOW COMPLETE			
5	03/16/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
4	03/05/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	03/03/2001	CORRESPONDENCE ADDRESS CHANGE			
2	02/10/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/15/2000	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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